APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,308	07/11/2001	Masayuki . Chatani	86277 [SCEA01005US00]	1011

22242   7590   07/13/2007
FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER
NGUYEN, PHUOC H

ART UNIT	PAPER NUMBER.
2143	

MAIL DATE	DELIVERY MODE
07/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/903,308	CHATANI ET AL.
	Examiner	Art Unit
	Phuoc H. Nguyen	2143

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _23 April 2007_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-88_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-88_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _April 23, 2007_.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible

for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been

timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR

1.114.

2.   Amendment received on April 23, 2007 has been entered into record.

3.   Claims 1-88 remain pending.

Response to Amendment

3.   This office action is in response to the applicants Amendment filed on April 23, 2007.

Claims 1-88 are presented for further consideration and examination.

Response to Arguments

1.   Applicant's arguments have been fully considered but they are not persuasive because of

the following reasons:

The applicant argues in page 3 that the cited references by McDonagh et al. does not

disclose a server offer as being "determining whether an upgrade could make any additional of

the plurality of predefined service levels available to the user device".

The examiner respectfully submits that the present submits that the prior art by McDonagh et al. clearly discloses that when the new service type is available it will then added to the service database and the user's profile to provide an update to reflect of the new service type (e.g. page 6 paragraph [0118]. In addition, McDonagh et al. further discloses that the user capable of accessing and altering the user profile such as enable certain type of services that become available (e.g. page 9 paragraph [0179]).

The applicant argues in page 6 that there is no suggestion of motivations to combine references.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. See **In re Nomiya, 184 USPQ 607 (CCPA 1975).** However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. See **In re McLaughlin, 170 USPQ 209 (CCPA 1971).** References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See **In re Bozek, 163 USPQ 545 (CCPA) 1969.** Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. See **In re Bode, 193 USPQ 12 (CCPA 1977).**

In this case, the reason for combining reference Sahai et al. and McDonagh et al. is that

Sahai teaches the service request from the client to the server, and the McDonagh capable of

accessing and altering the user profile by enable certain type of services (e.g. upgrading services)

that become available from the operator's site in which discloses that the user device also

requesting service from the service management device. Therefore, it would have been obvious

to incorporate McDonagh's teaching of making any additional of the plurality of predefined

service levels available to the user device in order to provide user with the latest updating

services which allow user choice to select which service(s) that the user willing to select.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over anticipated

Sahai et al. (Hereafter, Sahai) U.S. Patent 6,594,699 in view of McDonagh et al. (Hereafter,

McDonagh) U.S. Pub. No.: 2003/0045275.

Re claims 1, 30, and 58, Sahai's figure 1 discloses a method of managing the transfer of

content to a user device that is communicatively linked to a computer network, comprising:

obtaining user device information descriptive of a configuration of the user device (col. 2 lines

61-64; and col. 5 lines 5-6); determining capabilities of the user device to download content

over the network and to process content received over the network based upon the user device

information (col. 5 lines 5-14); automatically selecting a service level that is selected from

among a plurality of predefined service levels and is determined to be available to the user

device for transferring content thereto based upon the determined capabilities of the user device,

wherein the selected service level is associated with one or more characteristics of content for

transfer to the user device (col. 4 lines 32-63; and col. 6 lines 12-49); however, Sahai fails to

teach determining whether an upgrade could make any additional of the plurality of predefined

service levels available to the user device.

McDonagh teaches determining whether an upgrade could make any additional of the

plurality of predefined service levels available to the user device (e.g. the Bluetooth management

system (BMS) constantly receives the data such as device capabilities and based on the data

received the BMS then matches with the available services, and proactively transmits service

data to the user's mobile phone (e.g. Figure 1; page 2 paragraphs [0046-0049]; pages 4-5

paragraphs [0100-0105]; page 6 paragraph [0119]; and page 9 paragraph [0179]).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention was made to incorporate McDonagh's teaching into Sahai's method to determine

whether an upgrade the user device with a predefined service levels in order to provide an

offered the available predefined services in a more user friendly manner.

Re claims 2, 17, 31, 45, 59, and 73, Sahai further discloses receiving a request to transfer

content to the user device over the computer network, and causing content to be transferred to

the user device over the network according to the selected service level (Figure 2, and col. 6 lines

12-49).

Re claims 3, 32, and 60, Sahai further discloses a service level is also associated with one or more characteristics of the manner in which content is transferred to the user device over the network (col. 5 lines 7-26).

Re claims 4, Sahai further discloses identifying a list of content that can be transferred to the user device based upon the determined capabilities of the user device, and causing the list of content to be displayed at the user device (col. 6, lines 12-23).

Re claims 5, 23, 33, 51, 61, and 79, Sahai further discloses the user device information includes the amount of data (e.g. bit rate) that can be transmitted to the user device in a given amount of time over the network (col. 6 lines 12-49).

Re claims 6, 24, 34, 52, 62, and 80, Sahai further discloses the user device information includes the latency of the user device with respect to a content provider device on the computer network (col. 6 lines 12-49).

Re claims 7, 25, 35, 53, 63, and 81, Sahai further discloses the user device information includes the amount of data storage capacity available to the user device (col. 3 lines 23-60).

Re claims 8, 26, 36, 54, 64, and 82, Sahai further discloses the one or more characteristics of content associated with a service level includes the size of the content (col. 4 lines 9-31).

Re claims 9, 27, 37, 55, 65, and 83, Sahai further discloses the one or more characteristics of content includes whether the content includes graphic files (col. 4 lines 9-31).

Re claims 10, 28, 38, 56, 66, and 84, Sahai further discloses the one or more characteristics of content includes whether the content is art executable file (e.g. Java) (col. 6 last paragraph through col. 7 1st paragraph).

Re claims 11, 29, 39, 57, 67, and 85, Sahai further the manner in which the content is

transferred to the user device comprises streaming the content to the user device (Abstract).

Re claims 12, 18, 40, 46, 68, and 74, Sahai further discloses a first service level has a

corresponding minimum capabilities requirement, and further comprising selecting a first service

level for the user device only if the capabilities of the user device meet the minimum capabilities

requirements (col. 6 lines 35-49).

Re claims 13-14, 19-21, 41-42, 47-49, 69-70, and 75-77, Sahai reference discloses

selecting a service level for user device based upon the capabilities of the client device; however,

Sahai fails to teach notifying the user device of any available upgrade and notifying the user

device of changes that may be made to the configuration of the user device in order to upgrade

the capabilities of the user device.

McDonagh teaches notifying the user device of any available upgrade and notifying the

user device of changes that may be made to the configuration of the user device in order to

upgrade the capabilities of the user device (e.g. page 5 paragraph [0105]).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention was made to incorporate McDonagh's teaching into Sahai's method to notify the user

device of the upgrade in order for the user to identify possible actions that should be taken and

make a decision as to how to process the service data.

Re claims 15, 22, 43, 50, 71, and 78 Sahai reference discloses selecting a service level for

user device based upon the capabilities of the client device; however, Sahai fails to teach sending

one or more advertisements to the user device regarding changes that may be made to the configuration of the user device.

McDonagh teaches sending one or more advertisements to the user device regarding changes that may be made to the configuration of the user device (e.g. page 5 paragraph [0105]).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate McDonagh's teaching into Sahai's method to advertise the user device regarding to the changes that made to the user device in order for the user to identify possible actions that should be taken and make a decision as to how to process the service data.

Re claims 16, 44, and 72, Sahai further discloses obtaining user device information descriptive of a configuration of the user device (col. 2 lines 61-64; and col. 5 lines 5-6); identifying one or more service levels that may govern the transfer of content to the user device, wherein each service level is associated with one or more characteristics of content available for transfer to the user device and the manner in which content is transferred to the user device over the network, each service level being further associated with minimum requirements relating to the configuration of the user device and setting combinations of transfer parameters, making available at least one of the service levels to the user device for governing the transfer of content to the user device (col. 5 lines 5-14; and col. 6 lines 35-49); and automatically selecting a service level to govern the transfer of content to the user device based upon the user device information and whether the configuration of the user device meets minimum requirements for a service level (col. 6 lines 12-49); however, Sahai fails to teaches wherein selecting a service level is

performed at a network service manager device independent of a network provider from which the content is transferred.

McDonagh teaches determining wherein selecting a service level is performed at a network service manager device independent of a network provider from which the content is transferred (e.g. the Bluetooth management system (BMS) update a user profile by filter available services and push the selected services to the user (e.g. Abstract and page 3 paragraph [0069], the selected service is perform by the service manager which is independent from a network provider).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate McDonagh's teaching into Sahai's method to perform the service select from the BMS because the BMS is relative simple to perform the database management and service matching operation in order to offer the available predefined services in a more user friendly manner.

Re claims 86-88, Sahai reference discloses selecting a service level for user device based upon the capabilities of the client device; however, Sahai fails to teaches wherein selecting a service level is performed at a network service manager device independent of a network provider from which the content is transferred.

McDonagh teaches determining wherein selecting a service level is performed at a network service manager device independent of a network provider from which the content is transferred (e.g. the Bluetooth management system (BMS) update a user profile by filter available services and push the selected services to the user (e.g. Abstract and page 3 paragraph

[0069], the selected service is perform by the service manager which is independent from a

network provider).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention was made to incorporate McDonagh's teaching into Sahai's method to perform the

service select from the BMS because the BMS is relative simple to perform the database

management and service matching operation in order to offer the available predefined services in

a more user friendly manner.

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Safadi et al. U.S. Patent 7,120,926
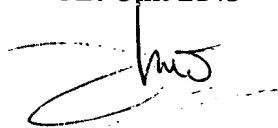
Bigham et al. U.S. Patent 5,740,075

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919.

The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Phuoc H Nguyen
Examiner
Art Unit 2143

July 5, 2007